REMARKS

Claims 1-25 remain in the application. Claims 1, 2, 9, 15 and 21 have been amended. Applicant respectfully requests reconsideration in light of the amendments and the following remarks.

CLAIM REJECTIONS UNDER 35 U.S.C §101

The Office Action rejected claim 15 under 35 USC §101 as being directed to non-statutory subject matter. Specifically, the Office Action contends that the invention is an abstract idea and cites *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994) in support. The Office Action then states that "claim 15 is non-statutory because it only recites a versioning tool with program code for packaging files. Applicant submits no substance that how this will be processed without incorporating a processor, memory and medium so its functionality can be realized." Office Action at 2.

The patent statute enumerates several classes of inventions that may be patented. Section 101 provides that:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The United States Court of Appeals for the Federal Circuit has noted that the repetitive use of

the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. *State Street Bank &Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 851 (1999). Moreover, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980); see also *Diamond v. Diehr*, 450 U.S. 175, 182 (1981). Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. *See Chakrabarty,* 447 U.S. at 308 ("The Federal Circuit has also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)). *State Street Bank & Trust Co. v. Signature Fin. Group, supra.*

In the instant case, claim 15, as amended, is directed to an invention in the manufacture statutory class. Therefore, the claimed invention is statutorily patentable unless the Patent Office establishes that the subject matter is in one of the judicially recognized categories exempted from patentability by the courts. From the rejection, the Examiner is apparently under the impression that software *per se* is not patentable. However, software *per se* is not one of the categories of non-patentable subject matter recognized by the courts. Moreover, there is no requirement that a processor, memory and medium must be recited to realize the claimed functionality. If that were the case, claims directed to components would not be allowed without reciting every other component required for realization. If what the Office Action contends were

the law then claims directed to a gear without the rest of the machine or claims directed to an integrated circuit without reciting other processing components would not be patentable because neither gears nor integrated circuits can by themselves realize their functionality. Not surprisingly, the Office Action cites no authority for this rejection. *Warmerdam* certainly does not support the rejection. In *Warmerdam* a purely mathematical construct was held to be non-patentable as an abstract idea. That is by no means the case in claim 15. Therefore, the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C §103

The Office Action rejected claims 1-25 under 35 USC §103 as being unpatentable over *Gupta* (U.S. 6,868,448) in view of *Mann* (U.S. 6,922,722). Applicant requests reconsideration.

The Office Action admits that *Gupta* does not teach transferring to a plurality of servers a package. See Office Action at page 3. However, the Office Action contends that *Mann* teaches this limitation. However, the Office Action provides no evidence whatsoever that there is a teaching, suggestion or motivation to combine the patents cited.

In order for any prior art references to be validly combined for use in a §103 rejection, the references themselves or some other prior art must suggest that they be combined. *In re Sernaker,* 217 USPQ 1, 6 (CCPA 1983). In deciding whether the prior art references are combinable it must be determined whether (1) all the prior art references are sufficiently related to one another and to a related and common art, that a person skilled in the art must be presumed

to be familiar with all of them; (2) whether a combination of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit; and (3) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication. *In re Sernaker,* 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Moreover, if prior art references require selective combination to conclude that an invention would have been obvious; there must be some teaching or suggestion in the references that would support their use in combination. *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied sub nom.* 475 U.S. 1017 (1986).

A piecemeal reconstruction of the prior art patents in light of the applicant's disclosure shall not be the basis for a holding of obviousness. *In re Kamm*, 172 USPQ 298 (CCPA 1972). Thus, it is impermissible within the framework of section 103 to pick and choose from any one reference only so much as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Kamm*, 172 USPQ at 302.

Assuming *arguendo* that the references were combinable, the combination does not teach or suggest the transmission to a server of an application and configuration data to configure the server. Certainly *Mann* does not teach or suggest that limitation. The part of *Mann*

cited does not: "In response to receiving first data packet 1118, configuration server 1140 transmits a data packet containing at least one of the requested alert detection and management parameters to alert-based managed client 1110 at processing block 1206." That says nothing about transmitting an application or data for configuring the server to run that application. Moreover, the limitation that the server configuration data transferred to the plurality of servers is the same for each server is not met by the combination because the data packet 1118 discussed in *Mann* is not the same as the claimed configuration data. The data packet is not the same for all servers to which it is sent. That is why the server in *Mann* sends only the requested alert detection and management parameters.

For the foregoing reasons, Applicant respectfully requests entry of the amendment and allowance of the pending claims.

Respectfully submitted,

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Certificate of Facsimile Transmission

I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being facsimile transmitted on this date, **January 15, 2007**, to the Commissioner for Patents, fax number 571 273-8300.

Michael J. Buchenhorner

Date: January 15, 2007